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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,835	10/19/2001	Alex S. Taylor	110914	7065

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EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/981,835		TAYLOR ET AL.	
	Examiner		Art Unit	
	Laurie Ries		2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-16,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-16,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 13 October 2005, to the original application filed 19 October 2001.
2. The rejection of claims 1-7, 9-16, and 18-19 under 35 U.S.C. 103(a) as being unpatentable over Price ("Linking By Inking: Trailblazing in a Paper-Like Hypertext") in view of Golovchinsky ("From Reading to Retrieval: Freeform Ink Annotations as Queries") has been withdrawn as necessitated by amendment and newly found prior art.
3. The rejection of claims 8 and 17 under 35 U.S.C. 103(a) as being unpatentable over Price ("Linking By Inking: Trailblazing in a Paper-Like Hypertext") in view of Golovchinsky ("From Reading to Retrieval: Freeform Ink Annotations as Queries") and Evans (U.S. Patent 6,363,179 B1) has been withdrawn as necessitated by amendment.
4. Claims 1-7, 9-16, and 18-19 are pending. Claims 2, 29, 44, and 50 have been cancelled. Claims 1, 28, 41, and 49 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9-16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price ("Linking By Inking: Trailblazing in a Paper-Like Hypertext") in view of Golovchinsky ("From Reading to Retrieval: Freeform Ink Annotations as Queries") and Lawton ("The Knowledge Weasel Hypermedia Annotation System").

As per claims 1-2 and 9-11, Price discloses a system and method of processing documents stored a database, including a source document and a target document (See Price, Page 33, Column 2, paragraphs 4-5, and Page 34, Column 1, paragraph 1) including a search device for searching the target document to identify whether any words of interest are present in the target document (See Price, Page 34, Column 1, paragraph 3), and an annotation device for annotating the words located in the target document in the same manner that they were annotated in the source document, such as highlighting (See Price, Page 34, Figure 5). Price does not disclose expressly detecting one or more annotated regions in a source document, and inputting and storing a number of words of interest, each of the words stored as a result of being annotated in the source document. Golovchinsky discloses retaining the selection of an instance of a word on a page where the word is stored as a result of an annotation, such as being highlighted by a user (See Golovchinsky, Page 22, Column 1, paragraphs 1-2). Golovchinsky also discloses that the selected word is annotated by

the user (See Golovchinsky, Pages 21-22, Section 4.3.1). Price and Golovchinsky are analogous art because they are from the same field of endeavor of using freeform ink annotations as queries. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and method of processing a target document of Price. The motivation for doing so would have been to accumulate information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1). Therefore, it would have been obvious to combine Golovchinsky with Price for the benefit of determining how often users select each word to obtain the invention as specified in claims 1-2 and 9-11. Additionally, Price does not disclose expressly that the source document and the target document are pre-selected from the database as the source document and the target document before the source document is annotated. Lawton discloses that a user selects various files of text, results and code and specifies that these are files to be annotated (See Lawton, Page 107, paragraph 7, lines 4-6). Lawton further illustrates the pre-selection of both a source and target file in a listing of annotation fields that are recorded in a database (See Lawton, Page 112, "Annotations", "Annotation Field", first two entries, "Source File" and "Target File"). Price, Golovchinsky and Lawton are analogous art because they are from the same field of endeavor of annotating documents. At the time of the invention it would have been obvious to one of ordinary skill in the art to include the pre-selection of a source and a target file for annotation of Lawton with the system and method of annotating documents of Price and Golovchinsky. The motivation for doing so would

have been to allow related documents, such as documents being used for a tutorial in a classroom setting, to be annotated such that the annotations highlight the relationship between the source and target documents (See Lawton, Page 107, paragraph 7). Therefore, it would have been obvious to combine Lawton with Price and Golovchinsky for the benefit of allow related documents to be annotated such that the annotations highlight the relationship between the source and target documents to obtain the invention as specified in claims 1-2 and 9-11.

As per claims 3 and 12, Price, Golovchinsky and Lawton disclose the limitations of claims 2 and 10 as described above. Price also discloses including a capture device for optically capturing a digital image of a physical source document (See Price, Page 35, Column 2, paragraph 6).

As per claims 4 and 13, Price, Golovchinsky and Lawton disclose the limitations of claims 3 and 11 as described above. Price also discloses detecting annotations in a captured image of the source document (See Price, Page 34, Column 1, paragraphs 2-3).

As per claims 5 and 14, Price, Golovchinsky and Lawton disclose the limitations of claims 4 and 13 as described above. Price also discloses detecting a type of annotation (See Price, Page 34, Column 1, paragraph 2).

As per claims 6 and 15, Price, Golovchinsky and Lawton disclose the limitations of claims 5 and 14 as described above. Price also discloses that the type of annotation detected includes one of highlighting, underlining, circling, crossing through, bracketing, bolding, italicizing, and coloring (See Price, Page 34, Column 1, paragraph 2).

As per claims 7 and 16, Price, Golovchinsky and Lawton disclose the limitations of claims 1 and 9 as described above. Price also discloses optically capturing a digital image of a physical target document to be annotated (See Price, Page 35, Column 2, paragraph 6).

As per claim 18, Price, Golovchinsky and Lawton disclose the limitations of claim 9 as described above. Price also discloses that the method is implemented by a set of program instructions stored in a storage medium and executable on a data processing device (See Price, Page 30, "Abstract").

As per claim 19, Price discloses a device implemented method of processing at least two documents including inputting a source document (See Price, Page 35, Column 2, paragraph 6, and Page 36, Column 1, paragraphs 1-2), inputting a target document, the target document pre-selected by a user of the device (See Price, Page 36, Column 1, paragraph 5). Price does not disclose expressly annotating the source document to identify a number of words of interest and storing the words of interest. Golovchinsky discloses retaining the selection of an instance of a word on a page where the word is stored as a result of an annotation, such as being highlighted by a user (See Golovchinsky, Page 22, Column 1, paragraphs 1-2). Golovchinsky also discloses that the selected word is annotated by the user (See Golovchinsky, Pages 21-22, Section 4.3.1). Price and Golovchinsky are analogous art because they are from the same field of endeavor of using freeform ink annotations as queries. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and

method of processing a target document of Price. The motivation for doing so would have been to accumulate information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1). Therefore, it would have been obvious to combine Golovchinsky with Price for the benefit of determining how often users select each word to obtain the invention as specified in claim 19. Additionally, Price does not disclose expressly that the source document and the target document are pre-selected from the database as the source document and the target document before the source document is annotated. Lawton discloses that a user selects various files of text, results and code and specifies that these are files to be annotated (See Lawton, Page 107, paragraph 7, lines 4-6). Lawton further illustrates the pre-selection of both a source and target file in a listing of annotation fields that are recorded in a database (See Lawton, Page 112, "Annotations", "Annotation Field", first two entries, "Source File" and "Target File"). Price, Golovchinsky and Lawton are analogous art because they are from the same field of endeavor of annotating documents. At the time of the invention it would have been obvious to one of ordinary skill in the art to include the pre-selection of a source and a target file for annotation of Lawton with the system and method of annotating documents of Price and Golovchinsky. The motivation for doing so would have been to allow related documents, such as documents being used for a tutorial in a classroom setting, to be annotated such that the annotations highlight the relationship between the source and target documents (See Lawton, Page 107, paragraph 7). Therefore, it would have been obvious to combine Lawton with Price and Golovchinsky for the benefit of allow related documents to be annotated such that the

annotations highlight the relationship between the source and target documents to obtain the invention as specified in claim 19.

Response to Arguments

6. Applicant's arguments with respect to claims 1-7, 9-16, and 18-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (571) 272-4136.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
1/6/2006